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REMARKS

The application has been reviewed in light of the Office Action dated July 31, 2006. Examiner Hashem is respectfully requested to reconsider the application in view of the following remarks set forth herein.

I. SUMMARY OF CLAIM AMENDMENTS

Claims 1, 12, 14, 19 and 20 are amended.

II. CLAIM OBJECTIONS

Claim 20 was objected to in the Office Action due to matters of form. Claim 20 has been amended to resolve the issues raised by the objection. Applicant requests that the objection be withdrawn.

III. CLAIM REJECTIONS***Under 35 U.S.C. § 112***

Claim 20 was rejected in the Office Action under 35 U.S.C. 112 as failing to comply with the written description requirement. The Office Action states that the claim was rejected due to it containing subject matter that was not described in the specification in such a way as to reasonably convey to one of skill in the art that the inventor had possession of the invention at the time the application was filed. Applicant respectfully traverses the rejection of Claim 20.

The original claims of an application are considered as part of the disclosure. See, e.g., In re Frey, 77 USPQ 116 at 119. In Frey the court stated that, "So far as we are advised, it long has

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been the practice of the tribunals of the Patent Office to treat subject matter recited in a claim embraced in an application as originally filed as being itself a part of the disclosure, even though it may not be defined in the specification, and that practice has been sustained by this court in numerous decisions." Id.

Although Claim 20 was amended in the Preliminary Amendment of October 20, 2004, the original version of Claim 20 sufficiently evidences that Applicant possessed the invention of Claim 20 on the date the present application was filed.

Applicant's position is supported by the MPEP. "[T]he fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled... the statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure." See, MPEP § 2164.

Nonetheless, Applicant has entered amendments to the specification which briefly disclose the features of Claim 20. The amendments to the specification do not introduce new matter as the features were sufficiently disclosed in the original Claim 20 to enable one of ordinary skill in the art to practice the invention. The MPEP specifically permits the entry of these amendments to the specification, and acknowledges that any such amendments do not constitute new matter. "[I]nformation contained in any one of the specification, claims, or drawings of the application as filed may be added to any other part of the application without introducing new matter." See, MPEP § 2163.06.

Applicant respectfully requests that the rejection of Claim 20 under this section be withdrawn.

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Claim 11 was rejected for lack of antecedent basis. Claim 11 has been amended to overcome this rejection. Application respectfully requests that the objection be withdrawn.

Under 35 U.S.C. § 103(a)

Claims 1-9 and 12-20 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,085,231 to *Agraharam et al.* (hereinafter the '231 patent) in view of U.S. Patent No. 6,483,899 to *Agraharam et al.* (hereinafter the '899 patent).

The '231 patent discloses a system which can deliver voice mail messages to an aliased email address. In the described system, if a telephone call is not answered, the system can allow for a voice mail message to be recorded. If the called party subscribes to the disclosed service, the voicemail can then be sent to an email address alias and delivered to a designated email account as a .wav file or a text file.

The '899 patent discloses a voice messaging system which can receive a voice mail message, convert the message into text, and deliver the message to an email account or a fax machine.

Applicant respectfully submits that, as detailed below, the cited references cannot support a *prima facie* case of obviousness of the subject matter of independent Claims 1 and 12, and as a matter of law, those claims that depend therefrom.

Courts have recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, either in the references themselves or in the knowledge of a person of ordinary skill in the art, to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. See e.g., *In re Dembiczak*, 175 F.3d 994 (Fed. Cir.

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1999); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996).

Applicant submits that the proposed combination fails at least the third prong of the obviousness test cited above in that the combination does not teach each of the features of the pending claims.

A. The Independent Claims

Claim 1 as currently pending is reproduced below:

Claim 1. A method of routing a text message to a second destination associated with a called party where a first destination is unavailable comprising the steps of:

- receiving a call to the first destination associated with a called party initiated by a calling party, wherein the first destination is unavailable;
- based on the unavailability of the first destination, requesting a voice message from the calling party;
- receiving the voice message provided by the calling party;
- converting the voice message into a text message based on determining an appropriate text format required by the second destination, *the text format being determined by retrieving formatting information for a selected device from a database, the database including routing information for a plurality of communication devices and a selected device designation, the routing*

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information including a list of directory numbers and formatting information for corresponding communication devices; and

forwarding the text message to the second destination associated with the called party, wherein the second destination comprises the selected device designated in the database.

Applicant respectfully submits that the hypothetical combination described in the Office Action does not include at least the features of Claim 1 highlighted above in bold italics. In this regard, both the '231 patent and the '899 patent are silent as to how a text format for a converted message is to be determined. The '899 patent mentions that destination devices can include fax machines, but does not further discuss how a text format is determined.

Applicant respectfully requests that the rejection of Claim 1 and any claims depending therefrom be withdrawn.

Claim 12 as currently pending is reproduced below:

Claim 12. A system for routing a text message to a second destination associated with a called party where a first destination is unavailable comprising:

a first switch for receiving a call to a first destination associated with a called party initiated by a calling party, wherein the first destination is unavailable;

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a network element, coupled to the first switch, for requesting a voice message from the calling party based on the unavailability of the first destination and receiving the voice message provided by the calling party; and

a voice recognition means, coupled to the network element, for converting the voice message to a text message based on determining an appropriate text format required by the second destination, *the text format being determined by retrieving formatting information for a selected device from a database, the database including routing information for a plurality of communication devices and a selected device designation, the routing information including a list of directory numbers and formatting information for corresponding communication devices;*

a second switch, coupled to the network element, wherein the network element forwards the text message to a second destination associated with the called party via the second switch, wherein the second destination comprises the selected device designated in the database.

Applicant respectfully submits that the hypothetical combination described in the Office Action does not include at least the features of Claim 12 highlighted above in bold italics. Again, as mentioned above with respect to Claim 1, both the '231 patent and the '899 patent are silent as to how a text format for a converted message is to be determined.

Applicant respectfully requests that the rejection of Claim 12 and any claims depending therefrom be withdrawn.

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B. The Dependent Claims

As discussed above, the dependent claims are allowable over the cited art for at least the reasons discussed above with regard to the independent claims from which they depend. In addition, these claims add features not found in either the '231 patent or the '899 patent. Any particular claim's inclusion or exclusion from the following discussion should not be construed as an indication of Applicant's opinion as to the relative merits of patentability of the dependent claims. Applicant merely wishes to direct the Examiner's attention to a number of selected claims and their corresponding features.

Claims 4 and 16 include the feature of receiving additional information from the calling party, a feature not disclosed in the cited art. Claims 5 and 18 depend from Claim 4 and 16 respectively and include the feature of the additional information comprising routing information of the second destination associated with the called party. Neither the '231 patent nor the '899 patent describe receiving any such information from a calling party. Claims 6 and 17 depend from Claim 4 and 16 respectively and include the feature of the additional information comprising an identification of the calling party. The cited art fails to disclose this feature.

Claim 7 includes the feature of the requesting step being performed in response to a Busy/No Answer trigger. The cited art makes no mention of any such trigger.

Claim 8 includes the feature of receiving routing information of the second destination from the called party. The Agraharam references do not disclose receiving any routing information from the called party.

Claim 11 adds to Claim 1 the feature of receiving a personal identification number, the personal identification number determining which one of the plurality of communication devices comprises the second destination. In rejecting this claim the Office Action cites column 3, lines

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9-61 and column 7, lines 30-41 of the '899 patent as disclosing this feature. Respectfully, Applicant is unable to find any discussion of a personal identification number in these passages or the use of any identifying information that would serve to determine which of a plurality of communication devices comprises a second destination.

Claim 19, as currently amended, includes the feature of the claimed network element receiving routing information of the second destination from the called party and storing the routing information in the database. Applicant respectfully submits that the cited art fails to teach or suggest any such feature. No mention is made of receiving routing information from a party and storing this information in a database.

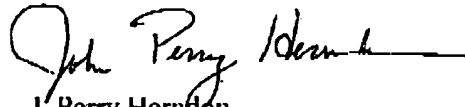
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IV. CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed July 31, 2006. Applicant thanks Examiner Hashem for her comments and for her consideration of these amendments. Applicant respectfully submits that the pending claims, as amended, are patentable over the cited references, and a Notice of Allowance indicating the same is respectfully requested. The preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

If Examiner Hashem believes any issues remain that can be resolved by a telephone conference, or there are any informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at the number listed below to discuss the same is respectfully requested.

Respectfully submitted,



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